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REMARKS

Claims 1, 2, 5-13, 16-21, and 23-35 are pending in the present Application. Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1, 21, 25, 26 and 31 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in relevant art that the inventors, at the time the s was filed, had possession of the claimed invention. In making the rejection the Examiner has asserted that the limitation "free of an alkylene-alkyl meth(acrylate) copolymer and an ethylene-alpha-olefin copolymer prepared using a single site catalyst that is at least partially modified with at least one alpha, beta-unsaturated dicarboxylic acid or derivative thereof".

It is here noted that MPEP 2173.05(i) provides an explanation as to the use of negative limitations. This section provides:

Any negative limitation or exclusionary proviso must have basis in the original disclosure. *** Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 20 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1193). (Emphasis supplied.)

In *Ex parte Parks*, the Examiner had rejected the limitation "in the absence of a catalyst" because there was no literal statement in the specification to support the limitation. The Board held that "literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112." *Id.* The Board also held that "it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed." *Id.* (Emphasis supplied.) In footnote 3, the Board points out that "whether the requirement for an adequate written description has been met is a question of fact and, hence, driven by the exigencies of each case." Applicants respectfully assert that one of ordinary skill in the art, upon

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reading the examples in the specification, would have know that the applicants had possession of the claimed composition.

Moreover, the Board of Patent Appeals & Interferences has consistently held that the specification does not require a literal statement supporting a negative limitation. In *Ex parte Kenneth E. Starling Jr., and Brian J. Love*, 1995 WL 1696871, *2 (Bd. Pat. App. & Inter. 1995), the claim language at issue was "curable without the application of any supplemental heat." The Board held, "Although the disclosure is silent as to the use of heat, **it can reasonably be said that appellants' silence would have disclosed to one of ordinary skill in the art that the dental adhesive would have been "curable in the absence of heat."** *Id.* (Emphasis supplied.) Thus, while Applicants' specification does not literally state Applicants' negative limitation as recited in Claims 1, 21, 25, 26 and 31, 35 USC 112, first paragraph, does not require a literal statement in the specification.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 2, 6, 7, 10, 16, 17, 19, 20, 21, 23, and 26-35 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,221,283 to Dharmarajan et al. in view of U.S. Patent No. 4,011,200 to Yonemitsu et al. Applicants respectfully note that Dharmarajan et al. is a reference under 35 U.S.C. § 102(e) and as such an obviousness rejection is only proper under 35 U.S.C. § 103(c). Applicants further note that Dharmarajan and the pending application were, at the time the invention of the pending application was made, owned by General Electric. Thus Dharmarajan cannot be used as a reference against the pending claims and Yonemitsu is not a sufficient reference alone to render the pending claims obvious.

Claims 5, 11-13, 24, and 25 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,221,283 to Dharmarajan et al. in view of U.S. Patent No. 4,011,200 to Yonemitsu et al. and U.S. Patent Application 2001/0031831 to Miyoshi et al. Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,221,283 to Dharmarajan et al. in view of U.S. Patent No. 4,011,200 to Yonemitsu et al. and U.S. Patent No. 6,258,572 to Patel. Claim 18 stands rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 6,221,283 to Dharmarajan et al. in view of U.S.

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Patent No. 4,011,200 to Yonemitsu et al and U.S. Patent No. 6,277,907 to Gelbin. Applicants respectfully assert that rejections employing these references is only proper under 35 U.S.C. § 103(c) and must be withdrawn due to the fact that Dharmarajan and the pending application were commonly owned as discussed above.

Claims 1, 2, 5-7, 10-13, 16, 17, 19-21, and 24-30 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent Application No. 2001/0031831 to Miyoshi et al. in view of U.S. Patent No. 4,011,200 to Yonemitsu et al. In particular the Examiner has stated that it would have been "obvious to use a PPE copolymer containing 2-50 wt% of 2,3,6-trimethyl-1,4-phenylene units (as per Yonemitsu et al.) for the copolymer described in Miyoshi et al." (Office Action dated April 4, 2003, page 4) Applicants respectfully traverse this rejection.

Miyoshi generally discloses compositions requiring polyphenylene ether, polyamide, an ethylene-alpha-olefin copolymer prepared using a single site catalyst, electroconductive filler, as well as an optional block copolymer. Miyoshi generally contemplates the use of a polyphenylene ether copolymer in paragraph 38. Miyoshi teaches in the examples and in the specification (paragraph 59) that the ethylene-alpha-olefin copolymer is, at least in part, modified with at least one alpha, beta-unsaturated dicarboxylic acid or derivative thereof. As readily understood by one of ordinary skill in the art, the modification of the ethylene-alpha-olefin copolymer is to improve the compatibility between the ethylene-alpha-olefin copolymer and the phases of the polyphenylene ether/polyamide blend. As mentioned to by the Examiner, Miyoshi does not teach the combination of SEBS and SEP impact modifiers. Yonemitsu et al. has been cited for its teaching with regard to the polyphenylene ether copolymer and does not, by itself, provide adequate basis for a prima facie case of obviousness.

The amended claims explicitly recite either a composition which is either free of an ethylene-alpha-olefin copolymer prepared using a single site catalyst that is at least partially modified with at least one alpha, beta-unsaturated dicarboxylic acid or derivative thereof or a composition that consists essentially of polyphenylene ether copolymer, polyamide, an electrically conductive filler and an impact modifier comprising a styrene-(ethylene-butylene)-styrene triblock copolymer, a styrene-(ethylene-propylene) diblock copolymer or a styrene-(ethylene-butylene)-styrene triblock

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copolymer and a styrene-(ethylene-propylene) diblock copolymer. Thus it is clear that the claimed compositions do not contain an ethylene-alpha-olefin copolymer prepared using a single site catalyst that is at least partially modified with at least one alpha, beta-unsaturated dicarboxylic acid or derivative thereof, a element required by Miyoshi et al. Yonemitsu et al. has been cited for its teaching with regard to polyphenylene ether copolymers and does not, by itself, provide adequate basis for a rejection under 35 U.S.C. § 103(a). Because Miyoshi et al. does not teach or suggest a compatibilized polyphenylene ether-polyamide composition that does not contain an ethylene-alpha-olefin copolymer prepared using a single site catalyst that is at least partially modified with at least one alpha, beta-unsaturated dicarboxylic acid or derivative thereof, the combination of Miyoshi et al. and Yonemitsu et al. does not form a prima facie case of obviousness for the amended claims.

Claims 1, 2, 5-7, 10-13, 16, 17, 19, 21, 26, 27, and 29 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over EP 0 924 261 to Koevoets et al. in view of U.S. Patent No. 4,011,200 to Yonemitsu et al.

Koevoets et al. generally describe thermoplastic compositions comprising a compatibilized polyphenylene ether-polyamide resin blend which is modified with an impact modifier containing at least moieties that are reactive with the polyamide resin. The preferred impact modifier is an alkylene-alkyl (meth)acrylate copolymer comprising at least two moieties selected from the group consisting of carboxylic acid, anhydride, epoxy, oxazoline, and orthoester.

The amended claims explicitly recite either a composition which is free of an alkylene-alkyl meth(acrylate) copolymer or a composition that consists essentially of polyphenylene ether copolymer, polyamide, an electrically conductive filler and an impact modifier comprising a styrene-(ethylene-butylene)-styrene triblock copolymer, a styrene-(ethylene-propylene) diblock copolymer or a styrene-(ethylene-butylene)-styrene triblock copolymer and a styrene-(ethylene-propylene) diblock copolymer. Thus it is clear that the claimed compositions do not contain an alkylene-alkyl meth(acrylate) copolymer, a element required by Koevoets et al. Yonemitsu et al. has been cited for its teaching with regard to polyphenylene ether copolymers and does not, by itself, provide adequate basis for a rejection under 35 U.S.C. § 103(a). Because Koevoets et al. does not teach or suggest a compatibilized polyphenylene ether-polyamide composition that does not contain an alkylene-alkyl

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meth(acrylate) copolymer, the combination of Koevoets et al. and Yonemitsu et al. does not form a prima facie case of obviousness for the amended claims.

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent Application No. 2001/0031831 to Miyoshi et al. in view of U.S. Patent No. 4,011,200 to Yonemitsu et al. and further in view of U.S. Patent No. 6,528,572 to Patel et al. Miyoshi and Yonemitsu have been described above. Patel generally discloses a composition comprising polymeric resin, electrically conductive filler, and antistatic agents.

For reasons similar to those discussed above, the combination of Miyoshi et al., Yonemitsu et al. and Patel et al do not provide adequate basis for a rejection under 35 U.S.C. §103.

Claim 18 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Miyoshi in view of Yonemitsu and further in view of U.S. Pat. No. 6,277,907 to Gelbin. Miyoshi and Yonemitsu have been described above. Gelbin generally discloses a method for stabilizing a thermoplastic resin, which may also contain carbon black and/or glass, wherein the method comprises adding to the resin a stabilizing amount of at least one sterically hindered phenol antioxidant, at least one secondary amine antioxidant and/or at least one N,N'-substituted oxamide antioxidant, and at least one thioether antioxidant.

For reasons similar to those presented above with regard to the combination of Miyoshi et al. and Yonemitsu et al., the combination of Miyoshi et al., Yonemitsu et al. and Gelbin does not provide adequate basis for a rejection under 35 U.S.C. §103.

Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Miyoshi in view of Yonemitsu and further in view of U.S. Patent No. 6,221,283 to Dharmarajan et al. Miyoshi and Yonemitsu have been described above. Dharmarajan et al. has been cited for its teaching with regard to incorporating filler into a thermoplastic composition as part of a masterbatch. Applicants respectfully submit that the combination of Miyoshi et al., Yonemitsu et al. and Dharmarajan et al does not provide adequate basis for a rejection under 35 U.S.C. §103.

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It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862.

Respectfully submitted,

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